

REMARKS

Claims 1-18 are pending in the subject application. By the instant amendment, independent claim 1 is amended to more particularly recite the subject matter of the present invention. Claims 3, 15 and 18 and the specification are amended to correct minor typographical errors. Further, new claims 19 and 20 are added. No new matter is added by the instant amendment, as support for the instant amendment may be found, e.g., in paragraphs [0063] and [0072]-[0074] and FIGS. 11A and 11B of the original specification. Claim 1 is the sole independent claim.

Applicants appreciate the Examiner's acknowledgement of applicants' claim for foreign priority and receipt of a certified copy of the priority document.

Applicants further appreciate the Examiner's indication of consideration of an Information Disclosure Statement filed November 30, 2004.

Applicants request, in the next Office action, that the Examiner indicate the acceptability of the drawings filed on October 15, 2003.

Claims 1-20 are presented to the Examiner for further or initial prosecution on the merits.

A. Introduction

In the outstanding Office action, the Examiner indicated that FIGS. 4A-4F are color photographs and required a petition under 37 C.F.R. § 1.84(a)(2), rejected claims 1, 2, 15, 17 and 18 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent No. JP2164412 to Kazuhiko ("the Kazuhiko reference"), and rejected claims 3-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over the Kazuhiko reference in view of U.S. Patent No. 6,554,880 to Northcutt ("the Northcutt reference").

B. Indication of Color Photographs in the Drawing Figures

In the outstanding Office action, the Examiner indicated that FIGS. 4A-4F are color photographs and instructed applicants to file a petition under 37 C.F.R. §1.84(a)(2) to have the photographs accepted. Applicants respectfully submit that the photographs of FIGS. 4A-4F are not color photographs, and no petition under 37 C.F.R. §1.84(a)(2) is required.

More specifically, FIGS. 4A-4F are black and white photographs illustrating damage that may occur to an air filter if a filter protection apparatus is not used to protect the air filter. These photographs are the only practical medium for demonstrating actual damage that may occur if the claimed invention is not used.

Accordingly, applicants respectfully submit that FIGS. 4A-4F, as originally filed, are acceptable and that no petition under 37 C.F.R. §1.84(a)(2) is required.

C. Asserted Anticipation Rejection of Claims 1, 2, 15, 17 and 18

In the outstanding Office action, the Examiner rejected claims 1, 2, 15, 17 and 18 under 35 U.S.C. § 102(b) as being anticipated by the Kazuhiko reference. By the instant amendment, independent claim 1 has been amended to more particularly recite the present invention. It is respectfully submitted that this amended claim defines the present invention over the cited prior art reference for at least the reasons set forth below.

In the apparatus of the present invention, a buffer space 700 of FIGS. 11A and 11B, “which is a space of a predetermined volume for absorbing the external disturbances, is formed between the air filter A and the filter protection apparatus, so that the filter A is protected from external disturbances.” *U.S. Pat. App. Serial No. 10/684,409, at § [0072]*. Thus, a protection part 300 of the present invention is spaced a predetermined distance apart

from an air filter to provide protection to the air filter. By the instant amendment, claim 1 has been amended to recite this aspect of the present invention, viz., "the protection part being spaced a predetermined distance away from the filter to protect."

On the contrary, in the Kazuhiko reference, the protection parts 52, 54, which the Examiner compares to the protection part 300 of the present invention, cover "the up side and down side of the filter material 50" within a frame 42. *See the Abstract and FIG. 3 of the Kazuhiko reference.* Thus, the Kazuhiko reference discloses forming protection parts 52, 54 on sides of the filter material. Accordingly, the Kazuhiko reference fails to disclose or suggest "the protection part being spaced a predetermined distance away from the filter to protect the filter from damage," as presently recited in claim 1.

In view of the above distinction between the present invention and the cited prior art reference, claim 1 is believed to be in condition for allowance, and a notice to such effect is respectfully requested. In addition, because the remaining claims, viz., claims 2, 15, 17 and 18, depend, directly or indirectly, from claim 1, claims 2, 15, 17 and 18 are believed to be similarly allowable as depending from an allowable base claim.

Accordingly, withdrawal of the rejection and favorable reconsideration of claims 1, 2, 15, 17 and 18 are respectfully requested.

D. Asserted Obviousness Rejection of Claims 3-14 and 16

In the outstanding Office action, the Examiner rejected claims 3-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over the Kazuhiko reference in view of the Northcutt reference. It is respectfully submitted that this rejection is traversed for at least the following reasons.

Claims 3-14 and 16 depend, directly or indirectly, from claim 1, which is believed to be in condition for allowance, as discussed above. Thus, claims 3-14 and 16 are believed to be similarly allowable as depending from an allowable base claim.

Further, the Northcutt reference fails to supply the teaching indicated above as being absent from the Kazuhiko reference.

Accordingly, reconsideration and withdrawal of the rejection of claims 3-14 and 16 are respectfully requested.

E. New Claims 19 and 20

By the instant amendment, new claims 19 and 20 are added. Claims 19 and 20 depend, directly or indirectly, from claim 1, which is believed to be in condition for allowance, as discussed above. Thus, claims 19 and 20 are believed to be similarly allowable as depending from an allowable base claim.

F. Conclusion

Since the cited prior art references, taken alone or in combination, neither anticipate nor render obvious the subject invention as presently claimed, applicants respectfully submit that claims 1-20 are now in condition for allowance, and a notice to that effect is respectfully requested.

The remaining document cited by the Examiner was not relied on to reject the claims. Therefore, no comments concerning this document are considered necessary at this time.

Finally, if the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all pending claims is hereby requested.

Respectfully submitted,

LEE, STERBA & MORSE, P.C.

Date: April 22, 2005


Eugene M. Lee, Reg. No. 32,039

LEE, STERBA & MORSE, P.C.
1101 WILSON BOULEVARD, SUITE 2000
ARLINGTON, VA 22209
703.525.0978 TEL
703.525.4265 FAX

PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.